

REMARKS

- Claims **34 – 45, 50 – 57** are currently pending in the Application.
- Of the pending claims, only claims **34, 42, 50, 51 and 52** are independent.
- All pending claims stand rejected.

1. Section 101 Rejection

Claim **52** stands rejected under 35 U.S.C. §101 because “the claimed invention is directed to non-statutory subject matter”. Applicants respectfully traverse this rejection. The Examiner has stated that “for a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.” Although, as explained in previous responses, the Applicants do not agree that this is a proper test for determining statutory subject matter under §101, Applicants have previously amended claim **52** to recite “*electronically providing a minimum number of diagnoses*” (emphasis added). Thus, claim **52** involves or uses the technological arts and is directed to statutory subject matter under the proposed two-prong test. Applicants respectfully request clarification regarding why claim **52** still stands rejected under §101.

2. Section 103 Rejection

2(a). Claims 34 – 41, 50 and 51

Claims **34 – 41, 50 and 51** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud (“Mayaud” herein) in view of U.S. Patent No. 6,144,943 to Minder (“Minder” herein) and in further view of U.S. Patent No. 6,046,761 to Echerer (“Echerer” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

2(a)(1). References do not teach or suggest claim limitations

None of the references of record, alone or in combination, teach or suggest the following claim feature, which is generally recited in each of these rejected claims:

- *establishing an agreement with an expert, wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for electronically providing a minimum number of diagnoses during a time period, the agreement being unassociated with any particular patient at the time of being established* (emphasis added)

Applicants agree with the Examiner that Mayaud does not teach this claim feature. Applicants, however, respectfully disagree with the Examiner’s interpretation of Minder as teaching this claim feature. The Examiner cites column 3, line 67 through column 4, line 12 of Minder as allegedly teaching this claim feature. However, Applicants have reviewed this portion, as well as the remainder

of Minder, and have been unable to find such a teaching. Minder explicitly teaches that an agreement for housekeeping services is for a particular facility, which is inherently owned or operated by a specific customer. (See for example, column 2, lines 36 – 39 and column 3, lines 33 – 36). For example, in the passage of Minder cited by the Examiner, a score is processed to give a grade that reflects the quality or thoroughness of services provided. The score is determined based on scores given to performance criteria. However, earlier passages of Minder make it clear that the performance criteria are ones selected by a manager for a particular facility. See, for example, column 3, lines 33 – 48. Accordingly, the agreement in Minder is not “unassociated with any particular [customer / facility] at the time of being established.”

Echerer does not teach or suggest any agreement with an expert, much less an agreement for periodic compensation in exchange for a minimum number of diagnoses. Echerer certainly does not teach or suggest that such an agreement would be unassociated with a particular patient at the time the agreement is reached.

Further, Applicants respectfully disagree with Examiner’s interpretation of Mayaud as teaching the following claimed features:

- *transmitting a plurality of requests to the expert, wherein each request comprises a request for a diagnosis of a physiological anomaly associated with a patient;*
- *receiving, from the expert, a response to each of the requests;*
- *receiving, for each response that is an acceptance of the request, the diagnosis for the patient of the request*

Mayaud teaches a prescription creation system for physician use that allows a physician to retrieve a patient's previous medical history from a database. The passages of Mayaud relied upon by the Examiner as allegedly teaching these claim features (col. 19, lines 17 – 24, col. 20, lines 20 – 31), as well as the remainder of Mayaud, merely describe that a physician may retrieve from a memory of the Mayaud system, previous and current medical problems, diagnoses and prescriptions of a patient. The physician's retrieval of this information from the memory of the system is not equivalent to *transmitting a request to an expert* for a diagnosis or anything else, or receiving from the expert a diagnosis or anything else. In the Mayaud system it is the doctor that is requesting the information stored in the memory of the system and it is presented to the doctor. The request for previous or active medical problems, diagnoses, and / or prescriptions is not being transmitted to a doctor or other expert but is rather being transmitted to a memory of a computing device. Similarly, the response to the doctor's request is received from the memory of the computing device and not from a doctor or other expert.

Regarding claim 35 in particular, Applicants respectfully disagree with the Examiner's assertion (Current Office Action (paper no. 13), page 5, paragraph 15) that Mayaud teaches the following claimed feature:

- *selecting the expert from a plurality of remote experts based on a received anomaly and an agreement*

The passage of Mayaud (col. 21, lines 34 – 41) relied upon by the Examiner for this assertion merely describes that a patient history stored in the Mayaud system may include drugs prescribed to a patient, the conditions for which they were prescribed, and the treating physicians. Applicants fail to see how this teaches selecting an expert from a plurality of experts based on a received anomaly

and an agreement. At most, this passage may be interpreted as describing that, in response to a patient identifier, a plurality of treating physicians associated with the patient may be retrieved. However, this is not equivalent to selecting a physician or another expert based on a received anomaly and an agreement. The remainder of Mayaud similarly does not teach or suggest this claimed feature.

With respect to claim 39, Applicants respectfully disagree that it would be obvious to include, in the Mayaud system, an indication of a factor that indicates a complication in providing the diagnosis, as discussed below in Section 2(a)(3). There is no suggestion in Mayaud that it would be at all desirable to store such an indication in the system. The Mayaud system is a tool for aiding physician in providing prescription to patients and concerns itself with providing factual information to the prescribing physician regarding a patient's previous and current medical history. There would be no need for a physician who is considering a prescription for a patient to know whether there was a complication in providing a diagnosis for the patient in the past. Rather, the physician is concerned with what the diagnosis was and the drugs that were prescribed therefore.

Further, the proposed modification to Mayaud is improper because it appears to be based on the alleged fact that Mayaud can be so modified. "Since the system of Mayaud tracks the number and nature of diagnoses by a particular physician, it is assumed that the more complicated diagnoses *could be* flagged in the record." Current Office Action (paper no. 13), page 6, paragraph 19, emphasis added. It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the proposed combination or modification. In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

Further still, the 103(a) rejection of this claim is improper because the Examiner has not provided any substantial evidence on the record as to why one of ordinary skill in the art would have been motivated to modify Mayaud as suggested. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP 2142.

Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Further still, the factual showings required to establish a *prima facie* case of obviousness must be supported by substantial evidence. As the U.S. Supreme Court has recently made clear, factual findings of the PTO must be supported by substantial evidence. Dickinson v. Zurko, 527 U.S. 150 (1999). Substantial evidence is such relevant evidence as a reasonable mind might accept to support a conclusion. Consolidated Edison Co. v. NLRB, 305 U.S. 197 (1938). The Federal Circuit has since followed this standard of review. In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by

substantial evidence. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001); emphasis added. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). See Baltimore and Ohio R. R. Co. v. Aberdeen & Rockfish R. R. Co., 393 U.S. 87, 91-92, 21 L. Ed. 2d 219, 89 S. Ct. 280 (1968) (absent reasoned findings based on substantial evidence effective review would become lost "in the haze of so-called expertise").

Substantial evidence is evidence that is documented on the record. The Supreme Court has described "substantial evidence" in the following manner:

"substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence." Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); See also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) ("Zurko III").

Assertions unsupported by the record do not qualify as substantial evidence. "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693

(Fed. Cir. 2001) (“*Zurko IV*”) (emphasis added). This requirement applies even though “the Board clearly has expertise in the subject matter over which it exercises jurisdiction.” *Zurko IV*, 258 F.3d at 1385 - 86. This expertise may provide sufficient support for conclusions as to peripheral issues, not the core factual findings. *Zurko IV*, 258 F.3d at 1386. Deficiencies in cited references “cannot be remedied by the Board's general conclusions about what is ‘basic knowledge’ or ‘common sense’ ”. *Zurko IV*, 258 F.3d at 1385 – 86.

In the present rejection of claim 39, the Examiner's assertion regarding the proposed modification of Mayaud is completely unsupported by any evidence, much less substantial evidence, and is thus flawed.

Further, Applicants note that if a *prima facie* case has not been made, Applicants have no duty to demonstrate that the invention is patentable, rebut the evidence, or anything else. In other words, if the Examiner fails to establish a *prima facie* case of obviousness, Appellants are under no obligation to prove the patentability of the claim. Nevertheless, Applicants have discussed above why claim 39 is patentable in light of the prior art.

With respect to claim 40, Applicants respectfully disagree with the Examiner's assertion that Mayaud teaches or suggests

- *a factor that indicates a complication, wherein the factor comprises at least one of (i) a greater than average complexity in the anomaly; (ii) a greater than average amount of time required to provide the diagnosis; (iii) an indication that the expert communicated directly with the patient; and (iv) an indication that the patient's life was saved due to the diagnosis*

At most, Mayaud describes (col. 42, lines 38 – 53) facts regarding a diagnosis, such as a time at which the problem was input into the system and the date the problem was resolved. This may be an indication of a length of treatment but it is not an indication of a complexity of the anomaly, a time required to provide the diagnosis (much less a comparison of such to an average amount of time required to provide a diagnosis) or any of the other factors recited in claim 40.

2(a)(2). Non-Analogous References

Applicants further respectfully traverse the 103(a) rejection of claims **34 – 41, 50 and 51** on the grounds that the references combined in the rejection are non-analogous.

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP 2141.01(a), quoting *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). “A reference is reasonably pertinent if [it]...logically would have commended itself to an inventor’s attention in considering his problem.” MPEP 2141.01(a), quoting *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

The housekeeping management system of Minder is completely outside the field of applicants’ endeavor of patient care diagnosis delivery. Further, Minder is not reasonably pertinent to the problems addressed by the present invention (e.g., facilitating provision of a diagnosis of a medical condition) and thus would not have commended itself to an inventor’s attention.

2(a)(3). Motivation to Combine

Applicants further respectfully traverse the 103(a) rejection of claims 34 – 41, 50 and 51 on the grounds that the motivations asserted for combining the references in the manners suggested (i) are not sufficient to establish a *prima facie* case of obviousness under the law, and (ii) would not in fact have motivated one of ordinary skill in the art to combine the references as suggested.

Regarding the combination of Minder and Mayaud, the Examiner has asserted that it would have been obvious to add the Minder scoring system into the Mayaud system “for the purpose of providing an objective measure for determining whether a physician is meeting a predetermined standard (see column 2, lines 25 – 29 of Minder).” Current Office Action (paper no. 13), page 4, end of paragraph 11. This assertion is a mere conclusory statement of an allegedly desirable result that may be obtained by the proposed combination of references and is thus insufficient to meet the Examiner’s burden. As discussed above, “the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP 2142. The Examiner has made no factual findings as to what objective teaching in the prior art would have motivated one of ordinary skill in the art, without first having read Applicants’ disclosure, to make the proposed combination.

Further, one of ordinary skill in the art would not have been motivated to make the proposed combination (even assuming the references are analogous, which they are not) because it does not make sense to add a quality scoring system

of Minder to the medical history storage system of Mayaud. The Mayaud system is a medical history storage system stores the medical history for a patient. There is no hint or need for addressing compensation to the physician in any form in Mayaud, as the Mayaud system is simply a data storage tool to aid physicians in prescribing medications.

Further, the Mayaud system has absolutely nothing to do with reaching any agreements with physicians to provide any diagnosis, much less of providing compensation to physicians for anything.

Further still, including the scoring and payment mechanism of Minder in Mayaud would discourage the use of the Mayaud system by physicians and thus frustrate the purpose of Mayaud of acquiring comprehensive medical history information for a patient. Mayaud describes that all of the information stored for a patient (i.e., the medical history for a patient) is accessible by any physician who is treating the patient and has access to the system and permission of the patient. Thus, it would not be desirable to store any information about a quality of service provided by a physician or compensation to be provided to the physician since physicians would be adverse to having this information viewable by other physicians who may be treating the patient. If such information were to be stored, physicians would be less likely to use the system due to a reluctance to have such information viewable by other physicians. Thus, a patient's medical history would be less complete if physicians were less likely to use the system and the purpose of Mayaud would be frustrated.

Further still, Mayaud does not describe or hint at any "predetermined standard" for a physician to meet. Accordingly, the motivation to combine Mayaud with Minder in order to allow a measure "of whether a physician is

meeting a predetermined standard” also fails because there is no need in Mayaud to perform such a measure.

Regarding the combination of Mayaud and Echerer, the Examiner has asserted that it would have been obvious to modify Mayaud to include the electronic requests for a diagnosis feature of Echerer “for the purpose of elimination unnecessary ‘face to face’ interaction between patient and doctor and, thereby, reduce costs for both parties.” Current Office Action (paper no. 13), pages 4 – 5, paragraph 12. This motivation also fails at least because it is merely a conclusory statement of a desirable result that may occur from the proposed combination. Such statements are insufficient to meet the Examiner’s burden, as discussed in the Response to the Office Action mailed August 27, 2003.

2(b). Claims 42 – 45

Claims **42 – 45** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer in view of U.S. Patent No. 5,216,596 to Weinstein (“Weinstein” herein) and further in view of U.S. Patent No. 5,634,468 to Platt et al. (“Platt” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

2(b)(1). References do not teach or suggest all claim limitations

None of the references, alone or in combination, teach or suggest the following claimed feature, which is generally recited in each of claims **42 - 45**:

- *an expert selected and contacted by the computing device based on the analysis [of an anomaly in at least one physiological parameter]*

The Examiner relies on Platt as allegedly teaching this feature. Current Office Action, page 8, paragraph 24. Applicants respectfully disagree with the Examiner's interpretation of Platt.

Platt merely describes sounding an alarm. "When an alarm is raised it is envisaged that the staff present at the analysis site would initiate medical intervention to alleviate the dangerous event." Platt, column 6, lines 8 – 13, emphasis added. Thus, there is no *selecting of an expert* by the computing device, much less doing so based on the analysis as is claimed. Relying on staff that responds to an alarm, rather than selecting and contacting an expert by the computing device, is undesirable and inefficient for the reasons described in the specification at page 1, paragraph [005] through page 2, paragraph [007].

2(b)(2). Motivation to Combine

Applicants further traverse the 103(a) rejection of claims **42 – 45** because no proper motivation to combine the references as suggested has been provided, and thus no *prima facie* case of obviousness established. The asserted motivations proposed by the Examiner (page 7, paragraph 23; page 8, paragraph 24; and page 9, paragraph 28) are merely conclusory statements of desirable results that may allegedly be obtained via the proposed combinations. Such statements are insufficient to satisfy the Examiner's burden of establishing a *prima facie* case of obviousness, as discussed in detail above and in the Response to the Office Action mailed August 27, 2003.

2(c). Claims 52 and 53

Claims **52 and 53** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer in view of Minder. Applicants respectfully traverse this rejection for the reasons set forth below.

2(c)(1). References do not teach or suggest all claim limitations

As explained above in Section 2(a)(1), neither Minder nor Echerer teach or suggest the following claimed feature, which is generally recited in each of claims **52 and 53**:

- *establishing an agreement with an expert, wherein the agreement specifies a periodic compensation amount that the expert will receive in exchange for electronically providing a minimum number of diagnoses during a time period, the agreement being unassociated with any particular patient at the time of being established* (emphasis added)

2(c)(2). Non-Analogous References

Applicants further respectfully traverse the 103(a) rejection of claim **52 and 53** on the grounds that the combined references are non-analogous. Applicants respectfully submit that Minder is a non-analogous reference for the reasons set forth in Section 2(a)(2) above.

2(c)(3). Motivation to Combine

Applicants further traverse the rejection of claims **52 and 53** on the grounds that no proper motivation to combine the references has been provided. The Examiner has provided the same motivation to combine Minder and Echerer as that provided for combining Echerer and Mayaud. As discussed in detail in Section 2(a)(3) above, this motivation fails at least because it is a mere conclusory statement of an allegedly desirable result that may be obtained from the proposed combination. Further, Echerer, like Mayaud, does not describe any predetermined standard for a physician to meet. Accordingly, as also described in Section 2(a)(3) above, this motivation further fails because there is no need in Echerer to measure whether a physician is meeting such a standard.

2(d). Claims 54 and 55

Claims **54 and 55** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud in view of Minder and Echerer and further in view of Platt. Applicants respectfully traverse this rejection for the reasons set forth below.

2(d)(1). References do not teach or suggest all claim limitations

First, as claims **54 and 55** are dependent from claim **52**, Applicants respectfully submit that claims **54 and 55** are patentable at least for the same reasons as claim **52**.

Further, regarding claim 55, Applicants respectfully disagree with the Examiner's assertion that Platt teaches or suggests selecting an expert, as explained in detail above in Section 2(b)(1).

2(d)(2). Motivation to Combine

Applicants further traverse the 103(a) rejection of claims 54 and 55 because no proper motivation to combine the references as suggested has been provided, and thus no *prima facie* case of obviousness established. The asserted motivations proposed by the Examiner (pages 10 - 11, paragraph 34; and page 11, paragraph 35) are merely conclusory statements of desirable results that may allegedly be obtained via the proposed combinations. Such statements are insufficient to satisfy the Examiner's burden of establishing a *prima facie* case of obviousness, as discussed in detail above and in the Response to the Office Action mailed August 27, 2003.

2(e). Claim 57

Claim 57 stands rejected under 35 U.S.C. 103(a) as unpatentable over Echerer in view of Minder and further in view of Platt. Claim 57 is dependent from claim 52. Accordingly, Applicants respectfully submit that claim 57 is patentable at least for the same reasons as claim 52, as discussed above.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461 - 7041 or via electronic mail at mfincham@walkerdigital.com.